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REMARKS

Claims 1-21 are pending in the present application. By virtue of this response, claims 1, 3, 7, 10, 13, 14, 17, and 20 have been amended. Accordingly, claims 1-21 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Amendments to the Specification

The abstract of the disclosure was objected to because it uses the word "means" and also due to its length of 180 words, which exceeds the 50 to 150 word limit.

Applicant has removed the word "means" from the abstract and has also shortened the abstract to conform with the limitation on number of words. The amendment adds no new subject matter.

The disclosure is objected to because of the following informalities:

Page 3, Par [0012]: "prize is paid is paid" should be changed to -- prize is paid --. Paragraph 12 has been amended accordingly.

In view of these amendments, Applicant respectfully requests withdrawal of the objections to the specification.

Amendments to the Claims

Support for claims as amended can be found in, *inter alia*, Figures 1 and 4-7, and paragraphs 19, 20, 27, 32, and 38.

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Claim Objections

Claims 1, 7, 10, 13, 14, 17, and 20-21 were objected to because of the following informalities:

Claim 1, Line 6: "event gaming machine" should be changed to -- event the gaming machine --.

Claim 1, Line 7: "the player" should be changed to -- a player --.

Claim 1, Line 8: "options which wager" should be changed to -- options in which the wager --.

Claim 7, 13, and 20: These claims should end with a period.

Claim 10, Line 4: "prize is paid is paid" should be changed to -- prize is paid --.

Claim 10, Line 7 and 9: "a prize" should be changed to -- the prize --.

Claim 10, Line 7: "the player" should be changed to -- a player --.

Claim 14, Line 3: "base game" should be changed to -- underlying game --.

Claim 17, Line 5: "an underlying" should be changed to -- the underlying game --.

Claim 17, Line 8 and 10: "a prize" should be changed to -- the prize --.

Claim 17, Line 8: "the player" should be changed to -- a player --.

Claim 21, Line 3: "base game" should be changed to -- underlying game--.

Applicant submits that the issues above have been addressed by the amendments to the claims and consequently requests withdrawal of the objections to the claims.

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Rejections under 35 USC § 102

Claims 1-3, 5-6, 10-11, and 15-17 were rejected under 35 USC § 102(e) as allegedly being anticipated by Baerlocher et al. (US 6,413,162).

The Examiner asserts that Baerlocher et al discloses the player being constrained to wager a single amount, referring to column 4 lines 60-65. However, the Applicant asserts that when properly construed Baerlocher et al teaches providing a player with the option to place a plurality of different wager amounts. Baerlocher et al does not appear to describe any constraint on the range of credits that may be wagered. Specifically, at column 4, lines 60-62 Baerlocher et al teaches that "The player can increase the bet by one credit each time the player pushes the bet one button 24."

Although in column 6, lines 36-44, Baerlocher et al describes a bonus round, which may begin when the player has achieved a qualifying condition, Baerlocher et al is silent on the requirements to provide eligibility to the bonus round. As explained previously, there are a plurality of wager options available to the player, so that the player is not constrained to wager a single amount on each play of a base game, with the wager also providing eligibility for a bonus or feature game.

The Examiner also asserts that claims 2, 5, 11, 15 and 18 are anticipated by Baerlocher et al, saying that Baerlocher et al describes only one button which initiates a play of the base game. The Examiner refers to column 4, lines 59-65. With respect, the Applicant believes that in this section of the patent Baerlocher et al only describes the mechanism by which the player can specify the size of the bet that he or she wishes to make, not the mechanism by which play is initiated.

Baerlocher et al describes a gaming machine in which the player must push a "bet one button 24" a number of times corresponding to the number of credits that he or she wishes to wager. Then, in order to initiate play of the game, another button is operated. Referring to column 5, lines 51-65, Baerlocher et al describes a plurality of "input devices 44", namely: "pull arm 18, play button 20, the bet one button 24..." and referring to column 6, lines 14-25, Baerlocher et al clearly

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describes initiation of play of the game by either the pull of the arm 18, or push of the play button 20.

The Examiner also asserts that claims 6 and 16 are anticipated by Baerlocher et al. Baerlocher et al describes a "play button 20", a "bet one button 24" and a "cash out button 26". This set of buttons is not equivalent to the set of buttons comprising buttons for "start or spin", "gamble", "take win", "collect" and "reserve".

It is submitted that the other claims rejected under this ground are not anticipated at least by reason of depending on a claim that is not anticipated.

Rejections under 35 USC § 103

Claims 4, 7-9, 12-14, and 19-21 were rejected under 103(a) as allegedly being unpatentable over Baerlocher et al. (US 6,413,162) in view of Vancura (US 6,033,307).

Vancura does not disclose constraining the player to a single wager option. As described in relation to the rejection under 35 USC § 102 above, Baerlocher et al also does not disclose constraining a player to a single wager option. Therefore the combination of Baerlocher et al and Vancura can not render claims 4, 7-9, 12-14, and 19-21 obvious.

Baerlocher et al specifically discloses the ability to wager varying amounts on the pay lines by repeatedly hitting the bet one button. In column 8, lines 35-43 Vancura also discloses a plurality of wager options, with the different wagering options described as buying payoffs for different symbols. Further disclosure of an ability to vary the wager in the game taught by Vancura can be seen from the remainder of the patent from column 8, lines 42 onwards, in particular Tables II - VII and column 13, lines 56-58. In view of this, Applicant submits that Baerlocher et al in view of Vancura does not render the claimed subject matter unpatentable under 35 U.S.C. Sec. 103.

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Claims 1-21 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Kirk et al. (GB 2,083,935) in view of Vancura (US 6,033,307).

As previously discussed, Vancura does not disclose constraining the player to a single wager option that provides eligibility for all pay lines and a bonus game. Kirk discloses a game that has 3 combination lines, a coin input and a game-initiating button.

The Examiner asserts that it would have been well known in the art at the time the invention was made that the fruit machine could be modified to have a simple 3x3, or more, matrix of gaming indicia viewable and that further pay lines could be used without increasing the single coin wager required. The Examiner also notes that Kirk fails to disclose a bonus game, but asserts that it would have been obvious to modify Kirk's fruit machine to include a bonus game feature.

The Applicant understands the Examiner's reasoning for this rejection as being: at the time of the Applicant's invention, it would have been obvious to take as the starting point for the design of a gaming machine the game machine taught by Kirk and then modify it to provide the claimed features including the modern feature of a bonus feature.

With reference to amended claim 1, in addition to requiring a bonus feature claim 1 requires display of symbols in a non-square matrix and a game having at least five pay lines through the matrix. These features of claim 1 are two further characteristics that are not disclosed by Kirk, but which may be found in modern gaming machines.

The claimed invention represents a very particular selection of the many different characteristics of modern gaming machines. The Applicant submits that the selection of these features is not obvious, as it represents applying a unique combination of modern and old features of gaming machines to achieve a useful result, there being invention at least in the identification of the combination of features to provide the useful result. The specification as filed describes possible useful results of the invention in comparison to other gaming machines at paragraph 10 on page 2.

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The combination of features defined in the independent claims explicitly omit the important characteristic of modern gaming machine that for multiple pay line gaming machines, the player is given the opportunity to purchase the pay lines that he or she wishes to wager on. The Applicant submits that at the time of the invention by the Applicant, the skilled person designing a gaming machine would include the option to purchase variable numbers of the pay lines, even if they were aware of Kirk.

Vancura for example discloses a complex arrangement for wagering options, with varying payouts and process available dependent on whether the player plays 1 coin, 2 coins or 3 coins (see for example tables II, IV and V and columns 8 and 9). Vancura also describes a requirement to bet 3 coins to be eligible for the bonus (see column 8, lines 35-43). In Baerlocher et al (US6,413,162), one of the drawbacks that is described as sought to be overcome is the problem that the odds of obtaining a particular combination would vary depending on which pay line the player played (see column 2, lines 30-47), which clearly implies that the player has a choice as to the pay lines to play.

When the invention was made, the focus of manufacture and development in the industry related to providing more pay lines and more bonus games, with a high number of wager options, with Vancura and Baerlocher et al providing examples. This movement of the industry away from game machines as taught by Kirk is described in the Applicant's specification at page 4, lines 15-35. The Applicant explains this development, starting with "traditional slot machines" that paid only on a centre row combination, through to machines providing matrices of pseudo spinning wheels such as a 3x3 matrix of wheels where every position on the display is essentially independent. This description of independent reels can be compared with US 6,413,162 (Baerlocher et al) relied on by the Examiner, which discloses a "gaming device having independent reel columns".

The Applicant's specification also explains that: "with existing gaming machines having multiple play lines available, also known as multi-line gaming machines the player purchases the option of playing for a win on lines other than the centre line. That is to say if he wagered one token the player played only for a winning combination on the centre line whereas if a number of tokens

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were wagered, the player chose (sic) to wager some of those tokens on lines other than the centre line in the display". Also, on page 1, lines 31-35, the Applicant's specification describes the requirement in some games to make an ante-bet prior to participating in a bonus game.

Therefore, the claimed combination of features of having a single wager option, but with a plurality of pay lines and a bonus game represents a novel and inventive combination. The Applicant respectfully submits that due to the abandonment of the old style gaming machines, it would not have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Kirk to reach the claimed invention. This is because it requires a very specific selection of features, such features being only represented separately in different approaches to gaming machine manufacture present in different periods in the history of gaming machine development. It is respectfully submitted that a conclusion of obviousness based on the references of record can only be reached by impermissibly using hindsight to first identify the individual features of the claim and then select those features out of distinct items of the references, without consideration of whether absent prior knowledge of the combination of features, that selection would have been made.

In addition, at the time the invention was made, a gaming machine designer wishing to make a multi-line gaming machine would not consider disclosures like GB 2,083,935 relevant. The designer would not start from the position of this outdated technology and seek to modify it to produce a new gaming machine, but would rather start with the position of modern gaming machines. In doing so, the gaming machine designer would implement a plurality of pay lines that are purchased by the player and seek to identify alternative ways of playing that game, as demonstrated by the art cited by the Examiner that has a filing date closer to the date of invention of the Applicant.

The Office Action also states that it was "well known in the art at the time the invention was made that the fruit machine [of Kirk, GB 2,083,935] could be modified to have a simple 3 x 3, or more, matrix of gaming indicia viewable and that further paylines could be used without increasing the single coin wager required." This assertion of fact is made in the Office Action, but

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no basis for this statement is readily apparent from the references cited by the Examiner. Applicant respectfully requests that the Examiner provide a reference disclosing such features as are found in Applicant's claims along with an explanation of why a person of ordinary skill in the art would necessarily consult that reference and select these features to combine with other features present in other references cited by the Examiner, or an Examiner's declaration to this effect so that the Applicant can better address the rejection.

Even if one or more references are available that illustrate features such as a matrix of viewable gaming indicia and additional paylines that could be used without increasing the single coin wager required, there is no reason apparent from the cited references why a person of ordinary skill would incorporate these features with the other features specified in the claims. The mere fact that a feature is known in the art does not provide sufficient guidance to a person of ordinary skill to combine that feature with other features from other references. Otherwise, the law allowing for patentability of a combination of known features would be eviscerated.

There is no reason apparent from the cited references for a person of ordinary skill in the field to necessarily seek out one or more references disclosing a matrix of viewable gaming indicia and additional paylines that could be used without increasing the single coin wager required, and there is especially no reason apparent for a person of ordinary skill to adopt a non-square matrix of symbols with five or more pay-lines and include a bonus game without also increasing the available wager options. In view of this, Applicant respectfully requests further information to support the rejection or, in the alternative, requests its withdrawal.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to *Deposit Account No. 03-1952* referencing docket no. 595122001700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By 

Charles D. Holland

Registration No.: 35,196
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-5832

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